



PATENT
Attorney Docket No. 06502.0340

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Michael SIJACIC et al.) Group Art Unit: 3627
)
Application No.: 09/867,652) Examiner: Cuff, Michael
)
Filed: May 31, 2001) Confirmation No.: 7976
)
For: METHODS AND SYSTEM FOR PERFORMING) **Mail Stop AF**
)
ELECTRONIC INVOICE PRESENTMENT AND)
PAYMENT DISPUTE HANDLING WITH LINE ITEM)
LEVEL GRANULARITY)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the Final Office Action dated November 19, 2007. This Request is being filed concurrently with a Notice of Appeal.

I. Requirements For Submitting a Pre-Appeal Brief Request for Review

Applicants have met each of the requirements for a pre-appeal brief review of the rejections set forth in the Final Office Action mailed November 19, 2007. The application has been at least twice rejected. Applicants have filed a Notice of Appeal with this Request, and have not yet filed an Appeal Brief. Lastly, Applicants submit a Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. See Official Gazette Notice, July 12, 2005. Therefore, Applicants request review of the Examiner's rejections in the Final Office Action for the following reasons.

II. The Rejection of Claims 1, 3, 4, 7-13, and 21-23 is Legally Deficient Because the Examiner Failed to Comply With 37 C.F.R. 1.104(c)

Applicants submit that the Examiner has failed to comply with 37 C.F.R. § 1.104(c). 37 C.F.R. § 1.104(c) requires the Examiner to provide more than merely stating a reference meets the limitations of a rejected claim. "When a reference is complex or shows or

describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." (emphasis added). 37 C.F.R. § 1.104(c)(2).

In this case, the Examiner rejects the claims of this application under 35 U.S.C. § 103(a) citing two references, U.S. Patent No. 6,044,362 to *Neely* ("*Neely*") and U.S. Patent Application Publication No. 2002/0062240 to *Morinville* ("*Morinville*"). Because the Examiner rejected the claims of this application under 35 U.S.C. § 103(a), and not § 102, Applicants submit that each reference applied by the Examiner necessarily describes inventions other than those claimed by Applicants. Therefore, the Examiner is required to designate the part of the references relied upon "as nearly as practicable." Moreover, the Examiner is required to do so for "each rejected claim."

A. The Examiner has not designated the part of the references relied upon as nearly as practicable

In the Office Action mailed June 7, 2007 ("the non-final Office Action"), the Examiner failed to comply with the M.P.E.P., or with 37 C.F.R. § 1.104(c)(2) by failing to cite with particularity to the prior art. Applicants pointed out these deficiencies on pp. 28-29 of the Reply to Office Action filed August 29, 2007 ("the Reply"), requesting that the Examiner identify the relevant teachings of each reference. In the Final Office Action mailed November 19, 2007 ("the final Office Action"), the Examiner has largely failed to do so.

To the limited extent that the Examiner cites with particularity to the art, the Examiner does not do so with any reference to the claims at issue. The Examiner relies almost entirely on the unfounded assertion that alleged "admitted prior art" discloses all of the limitations of the claims (non-final Office Action at p. 2). On p. 29 of the Reply, Applicants pointed out that the Examiner's allegations are entirely unsupported, and requested the Examiner to identify the particular portions of the specification with the specificity required by the M.P.E.P. and 37 C.F.R. § 1.104(c)(2). The Examiner responds by citing only to 3 lines of Applicants' specification, without applying the citation to any of the claims.

B. The Examiner has not explained the pertinence of the references for each rejected claim

In the non-final Office Action, the Examiner fails to even distinguish between independent claims 1, 7, 10, 13, and 21 (non-final Office Action at p. 2), each of which recite distinct subject matter. For example, claim 10 recites an "in-box reflecting a list of

invoices,” subject matter not recited in the other independent claims, and completely unaddressed in the non-final Office Action. Applicants pointed out these deficiencies in the Reply at p. 29, and requested the Examiner to address all of the recitations of the independent claims. In the final Office Action, the Examiner again fails to address any of the recitations of the various independent claims.

Further, the Examiner does not address any of the dependent claims. For example, dependent claim 8 recites “assigning [a] disputed first line item to a resolving entity.” This recitation goes entirely unaddressed in the non-final Office Action. Applicants pointed out this deficiency on p. 29 of the Reply. Again, in the final Office Action, the Examiner declined to address any of the dependent claims.

III. The Rejection of Claims 1, 3, 4, 7-13, and 21-23 is Legally Deficient Because the Examiner Failed to Comply With M.P.E.P. 707.07(f)

MPEP § 707.07(f) states, “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” The Examiner has failed to comply with M.P.E.P. § 707.07(f).

In the Reply, Applicants traversed the rejection by pointing out a number of deficiencies in the alleged prior art in Applicants’ specification as well as the cited references. In the final Office Action, the Examiner does not address Applicants’ position. Instead, the Examiner merely states:

Applicant asserts that the examiner has not shown enough relevance of the references. The examiner does not concur. The explanation provided makes the pertinence of each reference apparent.

(final Office Action at p. 4). However, the “explanation provided” by the Examiner is simply the language of the § 103(a) rejection - almost word for word identical to the rejection from the non-final Office Action that was traversed in the Reply.

Moreover, dependent claim 3 recites subject matter such as “displaying ... an indication that [a] second approver has disputed [a] first line item and approved [a] second line item.” On p. 32 of the Reply, Applicants pointed out that the cited references do not establish a prima facie case of obviousness with respect to claim 3. The Examiner does not address this argument in the final Office Action.

As discussed above, in the final Office Action the Examiner fails to address Applicants’ arguments with respect to the independent claims as well as dependent claim 3. Therefore, the finality of the Office Action is improper.

IV. The Rejection of Claims 1, 3, 4, 7-13, and 21-23 is Legally Deficient Because the Examiner Failed to Establish a *Prima Facie* Case of Obviousness

A *prima facie* case of obviousness has not been established because, among other things, none of Applicants' alleged admitted prior art, *Neely*, and *Morinville*, taken alone or in combination, render obvious the subject matter recited by Applicants' claims. The cited references fail to render obvious at least a "first invoice includ[ing] ... [a] first line item being disputed and [a] second line item being approved by [a] second approver," as recited in independent claim 10.

As discussed on p. 31 of the Reply, Applicants' specification identifies this subject matter as not taught by the prior art, stating: "[a]lthough such [prior art] services enable businesses to perform invoice processes electronically, dispute and payment processing is limited to the entire invoice. That is, if the purchaser disputed a particular line item within an invoice, the entire invoice would have to be disputed" (Specification at p. 3).

In response, the Examiner cites to p. 3, lines 7-9 of Applicants' specification (final Office Action at p. 2), which state:

Although current B2B EIPP systems, such as BizCast™ from Avolent and NetTransact™ from Bottomline Technologies @, manage invoices (such as tracking the status of individual line items), these systems do not allow line items to be processed according to a purchaser's specifications.

However, "tracking the status" of a line item does not necessarily include disputing or approving line items. Therefore, any admitted prior art in Applicants' specification fails to render obvious a "first invoice includ[ing] ... [a] first line item being disputed and [a] second line item being approved by [a] second approver," as recited by independent claim 10.

Neely is consistent with the prior art as discussed in the specification. *Neely* states that "a customer may pay less than the amount due on the invoice ... for a specific reason such as a dispute concerning a line item contained on the invoice" (*Neely* col. 5, lines 4-9). *Neely* thus discloses disputing an entire invoice by not paying the full amount for the invoice, and does not disclose that the invoice contains an approved line item and a disputed line item. Therefore, *Neely* fails to teach or suggest the claimed "first invoice includ[ing] ... [a] first line item being disputed and [a] second line item being approved by [a] second approver," as recited by independent claim 10.

Morinville fails to cure the deficiencies of the admitted prior art and *Neely*. *Morinville* was filed on Nov. 21, 2001, after the filing date of this application. *Morinville* is a CIP of U.S. Patent Application No. 09/770,163 ("the '163 application"), filed January 26, 2001,

which in turn claims priority to provisional application no. 60/179,555 ("the '555 provisional", filed February 1, 2000. Because *Morinville* is a CIP of the '163 application, not all of the subject matter disclosed in *Morinville* qualifies for the priority date of the '163 application.

The Examiner relies upon one page and one figure of the '163 application in the rejection, asserting that the '163 application "supports multiple management approvals for specific purchases" (non-final Office Action at p. 2). Even assuming the Examiner is correct, the '163 application does not support disputing or approving of individual line items. Therefore, *Morinville* does not rendering obvious a "first invoice includ[ing] ... [a] first line item being disputed and [a] second line item being approved by [a] second approver," as recited by independent claim 10.

Accordingly, Applicants' alleged admitted prior art, *Neely*, and *Morinville* fail to establish a *prima facie* case of obviousness with respect to claim 10. Independent claims 1, 7, 13, and 21, though of different scope from claim 10, recite limitations similar to those set forth above with respect to claim 10. Claims 3 and 4 depend from claim 1, claims 8 and 9 depend from claim 7, claims 11 and 12 depend from claim 13, and claims 22 and 23 depend from claim 21, and are therefore allowable at least due to their dependence from allowable base claims.

V. Conclusion

Because the Examiner's rejections of claims 1, 3, 4, 7-13, and 21-23 include legal deficiencies, Applicants are entitled to a pre-appeal brief review of the Final Office Action. Based on the foregoing arguments, Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 

Jeffrey A. Berkowitz
Reg. No. 36,743

Dated: January 18, 2008